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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,116	09/29/2003	Peter J. Dronzek JR.	181-030B	2428

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HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
GOFF II, JOHN L	

ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
08/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/674,116	DRONZEK, PETER J.	
	Examiner	Art Unit	
	John L. Goff	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-36 and 38-50* is/are pending in the application.

4a) Of the above claim(s) *48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-36,38-47,49 and 50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 5/13/08.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 25-27, 30-36, 38, 45-47, 49, and 50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gobel (U.S. Patent 3,296,723) in view of Malhotra (U.S. Patent 5,885,678) or Ito et al. (U.S. Patent 5,422,175), and optionally the admitted prior art (Specification page 4, lines 21-25).

See paragraph 4 of the office action mailed 2/13/08.

4. Claims 28, 29, 43, and 44 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gobel, Malhotra or Ito, and optionally the admitted prior art as applied to claims 25-27, 30-36, 38, 45-47, 49, and 50 above, and further in view of Jannusch (U.S. Patent 4,440,884).

See paragraph 5 of the office action mailed 2/13/08.

5. Claims 39-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gobel, Malhotra or Ito, and optionally the admitted prior art as applied to claims 25-27, 30-36, 38, 45-47, 49, and 50 above, and further in view of Kelly (U.S. Patent 4,978,436).

See paragraph 6 of the office action mailed 2/13/08.

Response to Arguments

6. Applicant's arguments filed 5/13/08 have been fully considered but they are not persuasive.

Applicants amendment has overcome the previous claim objections.

Applicant argues, "No test data was provided by Goebel to demonstrate if or how his PVC foil could be used to label a container. In addition Goebel did not mention of the use of a stack and feed or gripper type of label application device.".

Goebel describes the use of the PVC foil in the labeling of a container at column 1, lines 10-19 and 33-36 and column 2, lines 59-65 and column 3, lines 1-6 and column 4, lines 60-63 which specifically describe, "Gummed labels adapted to be adhered to bottles, cans and boxes through adherence of the moistened gum coating comprising in combination, a base selected from the class consisting of paper and polyvinyl chloride…".

Applicants claims are not commensurate in scope with the argument that Goebel does not mention the use of a stack and feed or gripper type of label application device as the claims do not require the use of a stack and feed or gripper type of label application device. The claims require "selecting a microvoided polymeric patch label that will readily feed from a label magazine or gripper…" and "applying a water based adhesive to said polymer label". The claims merely require that the microvoided polymer label be formed of a material that will, i.e. capable of, readily feed from a label magazine or gripper it being noted this is only required of the material exclusive of the adhesive, hydrophilic layer, etc. subsequently applied. Goebel as modified by Malhotra or Ito teach a microvoided polymer label formed of for example polypropylene considered capable of readily feeding from a label or magazine or gripper absent a

showing otherwise. The same applies to the limitation of "will allow a water based adhesive to migrate into said microvoided polymeric label". There is no requirement that the water based adhesive migrate into the microvoided polymeric label. Rather, the claims merely require that the microvoided polymer label be formed of a material that will, i.e. capable of, allow a water based adhesive to migrate into.

Applicant further argues, "Example 3 of Goebel has been repeated and the results are presented in the Declaration of Leslie Fernandez that is of record in U.S. 6,663,746. That Declaration provides data that shows that label of Example 3 will not dry and the treated surface remains sticky like cellophane tape so that those individual labels will stick to one another and cannot be used in a labeling machine where they are stacked one upon another. The amendatory language of claims 25, 47 and 50 points out that the claimed process uses a patch label that will readily feed from a label magazine or gripper. In addition claim 25 recites the direct application of an adhesive to the polymer label and does include the requirement of claim 26 that a hydrophilic layer be applied before the water based adhesive is applied. This language excludes a label as made in Example 3 of Goebel from the claims and there is nothing in Goebel that gives any motivation as to how to modify the surface of the PVC label of Example 3 so that the labels do not stick to one another.".

As noted above, the claims are not commensurate in scope with an argument that the label including the adhesive or hydrophilic layer thereon must readily feed from a label or magazine gripper as the claims do not require such.

Regarding the Declaration, the Declaration appears to perform Example 3 of Goebel with exceptions, e.g. the thickness of the PVC foil is different than in Goebel (50 microns as opposed

to 40 microns in Goebel), none of the coating weights are specifically as described in Goebel (6.6-9.7 grams per square meter as opposed to the specific 8 grams per square meter in Goebel), and drying was performed different than in Goebel (a heat gun as opposed to the drying Chamber in Goebel). The Declaration describes, "When samples of the dried PVC films and PET films were stacked upon each other in accordance with the physical arrangement of labels in a cut and stack label operation the dried PVC films and the dried PET films became tightly adhered to one another as if they were layers of pressure sensitive cellophane tape that were superimposed on one another.". The Declaration is not persuasive for the following reasons. The "dried PVC films" referred to are apparently PVC foils with hydrophilic coating stacked upon each other. The claims do not require that the "microvoided patch label that will readily feed from a label magazine or gripper" have a hydrophilic coating thereon as more fully described above, i.e. the claims are not commensurate in scope. Additionally, applicants have not shown that a microvoided label with hydrophilic coating thereon will readily feed from a label or magazine gripper. Finally, the Declaration does not demonstrate what is required by "will readily feed from a label magazine or gripper", e.g. via quantitative results, nor does the Declaration specifically determine if the PVC foil with hydrophilic coating will readily feed from a label magazine or gripper.

Applicant further argues, "The pressure sensitive *polypropylene* label of Malholtra does not suggest any modification of the hydrophilic coated *PVC* label of Goebel. Malholtra uses a pressure sensitive adhesive while Goebel suggests a water based adhesive.".

There is no teaching or suggestion in Malhotra that the use of microvoided polypropylene labels is a function of specifically using pressure sensitive adhesive. Malhotra teaches at column

6, lines 30-64 "Any suitable substrate can be employed..." which substrates include paper, PVC and microvoided polypropylene wherein microvoided polypropylene has a strength advantage as a "never tear paper". Goebel suggests paper, PVC, etc. as exemplary labeling materials without limitation wherein Malhotra simply evidences that further exemplary labeling materials readily known to one of ordinary skill in the art in addition to those specifically disclosed in Goebel include microvoided polypropylene.

Applicant further argue, "The Ito patent only discloses a voided material that can be used for labeling and there is no reason to combine this patent with Goebel because if the voided film is used in place of the film and paper of Goebel the labels would not require the treatment taught by that patent. There is no mention in Ito of what type of adhesive could or should be used if the product is used to make labels.".

Applicants argument that the material taught by Ito would not require the treatment taught by Goebel is unclear. Applicants have not demonstrated any evidence that such a treatment teaches away from the combination, and it is unclear what evidence might be provided as applicants use and claim a hydrophilic treatment.

Regarding applicants arguments to Jannusch, Jannusch is cited simply to show a water based adhesive which maintains a strong bond between a label and an object to which it is attached wherein the adhesive comprises gum, starch, casein, etc. and includes a crosslinking catalyst to provide a quick bond. Applicants have not advanced any specific arguments for the above.

Applicants further argue, "It is not seen how the applicant can be required to test a hypothetical composition that can only be made by selecting materials from two references that

can only be combined as a result of the applicants disclosure. The applicant was the one who first used a water based adhesive on a microvoided label. Any testing of the prior must be directed to the state of the art before the applicant made what is conceded to be a novel contribution to the art or the test will merely be a demonstration of the applicants invention. It is requested that the Examiner reconsider the Declaration of Leslie Fernandez and withdraw the rejections of record."

As noted above, the Declaration does not show that a microvoided label with hydrophilic coating thereon will readily feed from a label or magazine gripper such that it is not possible to draw any conclusions from the Declaration.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1791